

06/13/01  
Hearing:  
March 6, 2001

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB**

Paper No. 13  
DEB

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Structural Bioinformatics, Inc.

Serial No. 75/476,096

James C. Weseman and Felix J. D'Ambrosio of The Law Offices of  
James C. Weseman for Structural Bioinformatics, Inc.

Jessie Warman Billings, Trademark Examining Attorney, Law Office  
103 (Michael Hamilton, Managing Attorney).

Before Quinn, Walters and Bucher, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Structural Bioinformatics,  
Inc. to register the mark shown below:

**GeneNetX**

for "consulting services in the field of bioinformatics and in  
the use of computer software and databases relating thereto."<sup>1</sup>

The Trademark Examining Attorney has refused registration  
under Section 2(e)(1) of the Act, 15 U.S.C. 1052(e)(1), on the

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<sup>1</sup> Application Serial No. 75/476,096, filed on April 28, 1998, based  
upon an allegation of a *bona fide* intention to use the mark in  
commerce in connection with the above identified services in Int. Cl.  
42.

ground that applicant's mark is merely descriptive of the services recited in the application.

When the refusal was made final, applicant appealed. Both applicant and the Trademark Examining Attorney have filed briefs. At applicant's request, an oral hearing was held before this Board.

We affirm the refusal to register.

The Trademark Examining Attorney maintains that the term "GeneNetX," when sounded out phonetically, is the word "genetics," and that despite the novel spelling of the word, it is merely descriptive of applicant's consulting services in the field of bioinformatics.

On the other hand, applicant argues that its intention is that both "Gene" and "Net" should be given their ordinary emphasis and be pronounced separately (i.e., "Gene"- "Net"- "X"), in which case the Trademark Examining Attorney is in error about the pronunciation of this coined term. Secondly, applicant contends that the Trademark Examining Attorney has too easily glossed over the differences between the fields of genetics and bioinformatics.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately

describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the characteristics, properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature thereof. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the very goods or services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

The first question before us is whether the term "Genetics" is merely descriptive in connection with applicant's services. We first turn to the evidence made of record by the Trademark Examining Attorney to support her contention that the term "genetics" is merely descriptive of applicant's consulting services.

The Trademark Examining Attorney has submitted a dictionary definition of the word "genetics" as meaning "the branch of science that deals with heredity, especially the mechanisms of hereditary transmission and the variation of inherited characteristics among similar or related organisms." She has

also placed into the record a variety of excerpts from the LEXIS/NEXIS database, of which the following are representative:

David Baker, an assistant professor of biochemistry and bioengineering at the UW, also is digging deeply into bioinformatics.

Baker and his colleagues are trying to take genetic sequence information and, with computational help, analyze it to try and predict the shapes and functions of various proteins... . ("21<sup>st</sup> Century Marriage - Biology, Computers," Seattle Post-Intelligencer, May 18, 1999, P. A-1)

... Researchers from the Southeast and Mid-Atlantic region will discuss the latest in the emerging field of bioinformatics - the study of quantitative genetics using advanced mathematical, statistical and computational analysis... . ("A Pure Sport," The News and Observer (Raleigh, NC), February 17, 1999, p. B5)

Companies can also use bioinformatics to analyze genetic data and pinpoint individuals who, because of their genetic makeup, would benefit from a new drug ... . ("Bay State biotechs see future growth in bioinformatics," Boston Business Journal, February 12, 1999, p. 1)

... As biologists worldwide use their skills to create genetic roadmaps, called genomes, students of bioinformatics are learning to harvest that information with the help of computer programs... . ("RPI helps to bring genetic mapping into computer age," The Times Union, (Albany, NY), September 26, 1998, p. B1)

In fact, when applicant states its position on this question in some detail, it corroborates the above, as follows:

Applicant agrees that the field of bioinformatics (the relevant field for applicant's services) does include aspects in common with the field of genetics, but it is the difference between the

two fields which helps to refute the erroneous conclusions drawn by the Examining Attorney. Bioinformatics, the stated field for applicant's services, involves the use of computers and sophisticated information processing techniques to extract information from gene and protein structure, and utilize the information in the design and development of novel drugs, proteins and other molecular structures.

(Applicant's reply brief, p. 2).

As to the field of bioinformatics, the common strand throughout applicant's briefs and all of the NEXIS excerpts contained in the record is the use of computers to process large amounts of biologically-derived information. While some of the quotations in the file use the term "bioinformatics" to describe broadly any use of computers to handle biological information, many are used in a narrower sense to describe the use of computers to understand the molecular components of living things, and especially genetic material.

Furthermore, these excerpts, like applicant's recital of services, all demonstrate that much of the current bioinformatics work is concerned with the technology of databases. The best known of these databases involves "The Human Genome Project," a detailed map of human DNA. ("Genome research center gets new home," The Santa Fe New Mexican, August 15, 1999, p. D-1). The biologists and geneticists quoted in these excerpts who talk about "doing bioinformatics" are using

computers to store, retrieve, analyze or predict the composition or the structure of biomolecules, including genetic material.

Clearly, genetics and bioinformatics are closely related fields, and increasingly, are overlapping. Applicant concedes that bioinformatics "does include aspects in common with the field of genetics." There are differences in that genetics is a traditional life science while bioinformatics has married advanced computation to the life sciences. However, under the test for merely descriptive matter under the Lanham Act, we find that in fact, the word "genetics" conveys information about one of the *primary purposes* for the current importance of, and recent spectacular growth in, the field of bioinformatics. Accordingly, we conclude that if the term in question were the word "genetics," undoubtedly it should be held merely descriptive of a primary purpose for the field of bioinformatics, and that logic extends to applicant's "consulting services" in this field.

Having found the term "genetics" merely descriptive in this context, we turn next to the question of whether, as argued by the Trademark Examining Attorney, applicant's alleged trademark, "GeneNetX," would be perceived by relevant consumers as the term "genetics"?

Whether a novel spelling of a descriptive term is also merely descriptive depends upon whether purchasers would

perceive the different spelling as largely the equivalent of the descriptive term. As Professor McCarthy notes, a "slight misspelling of a word will not generally turn a descriptive word into a non-descriptive mark." 2 T.J. McCarthy, McCarthy on Trademarks and Unfair Competition, §11.31 (4<sup>th</sup> Ed. 1998).

Nonetheless, applicant argues that the Trademark Examining Attorney has taken liberties with its corrupted spelling:

The distinct syllables "Gene" and "Net" are not pronounced "ge-net" or "genet," as the [Trademark Examining Attorney's] argument concludes, but instead are encouraged to be pronounced separately and distinctly as "Gene" and "Net" - precisely as applicant intends.

(Applicant's reply brief, p. 2).

The predecessor to our primary reviewing Court had to face this question under the terms of the Lanham Act on a number of instances. See Andrew J. Mcpartland, Inc. V. Montgomery Ward & Co., Inc., 76 USPQ 97 (CCPA 1947), cert. denied, 333 U.S. 875, 77 USPQ 676 (S. Ct. 1948) ["KWIXTART," phonetic spelling of "quick start," is descriptive of electric storage batteries]; and In re Hercules Fasteners, Inc., 203 F.2d 753, 97 USPQ 355 (CCPA 1953) ["FASTIE," as phonetic spelling of "fast tie," connotes that which unites or joins quickly, and hence the notation is descriptive of the function and character of tube sealing machines]. Our own precedent demonstrates that a slight misspelling of a descriptive (or misdescriptive) term is

insufficient to avoid the proscription of Section 2(e)(1), so long as the corrupted term is likely to be perceived by the public as the equivalent of the descriptive term. See In re Organik Technologies Inc., 41 USPQ2d 1690 (TTAB 1997) ["ORGANIK," phonetic equivalent of word "organic," is misdescriptive of applicant's cotton textiles and clothing]; In re State Chemical Manufacturing Co., 225 USPQ 687 (TTAB 1985) ["FOM," equivalent to word "foam," is descriptive for foam rug shampoo]; and In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982) ["TOOBS," the phonetic equivalent of the word "tubes," is a descriptive name that may be used for applicant's bathroom and kitchen fixtures in the form of curved tubes which serve as holders and racks].

Granted that prior decisions are of limited value in deciding trademark issues such as this, comparing the alleged mark, "GeneNetX," with the word "genetics," whether one focuses on the visual or alleged phonetic differences, we find that the corruption herein is no more significant than with rejected terms like KWIXTART/quick start batteries,<sup>2</sup> FASTIE/fast tie

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<sup>2</sup> For example, in Mcpartland v. Montgomery Ward supra, if one slowly and carefully articulates each syllable of KWIXTART, logically breaking the two syllables between the letters "x" and "t," the pluralized sound (iks) of the first syllable of the asserted mark (KWIX or quicks) creates "quicks-tart." In effect, with the corrupted spelling, the "s" sound has moved from the second syllable to the first, producing a slightly different iks (or "x") sound, and changing the second syllable from "start" to "tart." If one analyzes the phonemes involved, "quicks-tart" is arguably distinguishable as



sealing machines,<sup>3</sup> ORGANIK/non-organic cotton fabrics, FOM/foam carpet cleaner or TOOBS/curved tube fixtures. We are without any doubt that applicant's mark "GeneNetX" would be perceived by the relevant public to be the equivalent of "genetics."

As seen in the cases from the predecessor to our reviewing Court, cited *supra*, the corrupted spelling need not be pronounced exactly the same as the descriptive term. In ordinary usage, the "jĕn•nĕt" of applicant's claimed mark will not be easily distinguished from the "je•nĕt" of the descriptive word, genetics.<sup>4</sup>

And finally, in spite of the phonetic analysis above, it has been repeatedly stated that "there is no correct pronunciation of a trademark." *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969), and *Yamaha International Corp. v. Stevenson*, 196 USPQ 701 (TTAB 1977), and cases cited therein.

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sounded out from the descriptive term, "quick-start." However, such a fine difference did not stop the Court from finding QUIXTART to be descriptive of "quick-starting" batteries.

<sup>3</sup> In *Hercules Fasteners supra*, where the CCPA found FASTIE to be descriptive for "fast tie" sealing machines, the Court's decision was not changed by the fact that normally one might find a strong, double "T" sound at the confluence of these two syllables "fast" • "tie".

<sup>4</sup> Similar to the strong, double "T" sound at the confluence of the two syllables "fast" • "tie" ("FASTIE") in *Hercules Fasteners supra*, in the instant case the normal pronunciation of the first two syllable herein ("Gene" and "Net") would provide for a long, double "N" sound at the confluence of these two syllables (jĕn•nĕt).

Next, applicant points out that its mark emphasizes the word "Net," with its alternative meaning readily picked out by the computer literate:

... any individuals or companies working in the field of bioinformatics will be highly knowledgeable and computer literate. To such individuals and companies, the relevant consuming public, the novel spelling and presentation inherent in applicant's mark, and particularly the emphasis in setting apart the term "Net" will be suggestive of the use of internet or computer services ... and involve "genes," the lead component of the subject mark.

As to applicant's argument that the "Net" portion of the mark may have a connotation of the Internet, we find that such a suggestion will not detract from the overwhelming impression of the mark as a whole as being the phonetic equivalent of the word "genetics," even for those who are experts with computers and the Internet. Moreover, we agree with the position of the Trademark Examining Attorney that this might explain the origins of the "Gene" and "Net" syllables of applicant's mark, but there is no suggestion in the file for what role the capitalized and final letter "X" plays in this mark,<sup>5</sup> other than to create a novel combination having the phonetic equivalence of "genetics."

With respect to the alleged sophistication of applicant's prospective purchasers, we acknowledge that despite the absence

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<sup>5</sup> "The mark could properly (or phonetically) be pronounced as 'Gene-Net-X' (or 'Gene-Net-Ten' if the 'X' were perceived as a Roman numeral)... ." (Applicant's brief, p. 2).

of any evidence on this point, these services are likely to be directed to fairly knowledgeable persons. However, we conclude that the sophistication of purchasers herein does not help applicant much in this case. The fact is that this misspelling, when used in connection with the identified services, will be perceived as "genetics" whether the purchasers are highly educated or not. One could even argue that one knowledgeable about this field might spot "genetics" even more readily than others.

Finally, we should respond to applicant's argument that the concept of "fair-use" protects others doing consulting work in the field of bioinformatics in their use of the descriptive word "genetics." While that is undoubtedly true, that fact does not absolve this Board from our responsibility to apply Section 2(e)(1) of the Lanham Act to the case before us. Furthermore, under our trademark law, all of applicant's competitors have "the right to be free from claims of exclusive right by others and from harassment based on such claims" against their use in their businesses of language which is accepted terminology in that field. See State Chemical Manufacturing, *supra*.

Decision: The refusal to register is affirmed.